

REMARKS

Claims 1-21 were pending in this application.

Claims 1-21 have been rejected.

Claims 1, 3, 11, and 19 have been amended as shown above.

Claims 1-21 remain pending in this application.

Reconsideration and full allowance of Claims 1-21 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects Claims 3-6 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office Action asserts that the phrase “said lockable cache line” in Claim 3 lacks antecedent basis.

The Applicants have amended Claim 3 to correct the ambiguity noted in the Office Action. The Applicants have also amended Claims 11 and 19 to correct similar problems. The Applicants respectfully assert that all pending claims are definite.

Accordingly, the Applicants respectfully request withdrawal of the § 112 rejection.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 7-10, and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,135,651 to Leinfelder et al. (“*Leinfelder*”) in view of U.S. Patent Application No. 2002/0120810 to Brouwer (“*Brouwer*”). The Office Action rejects

Claims 3-6, 11-14, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over *Leinfelder* and *Brouwer* in further view of U.S. Patent No. 5,950,012 to Shiell et al. ("*Shiell*"). The Applicants respectfully traverse these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

Leinfelder recites a "software patch method and apparatus." (*Abstract*). The method and apparatus are used to replace "selected portions" of computer software. (*Col. 1, Lines 33-35*). In an array of "content addressable memory (CAM)" cells, a program address for the installed software is compared to address locations from a "patch table." (*Col. 1, Lines 35-42*). When a match is found, one or more replacement instructions are provided. (*Col. 1, Lines 42-51*).

Leinfelder simply recites that a "patch table" contains addresses, which are compared to addresses in an array of CAM cells. *Leinfelder* lacks any mention that the patch table contains both address locations of instructions to be replaced and replacement instructions for the instructions to be replaced. As clearly shown in Figure 1B of *Leinfelder*, the patch table is only used to store addresses. As a result, *Leinfelder* fails to disclose, teach, or suggest a "patch table" containing a "first new instruction" and "a first patch address identifying a first patched ROM address" as recited in Claims 1, 9, and 17.

Also, as acknowledged in the Office Action, *Leinfelder* fails to disclose, teach, or suggest a "lockable cache," storing a "first replacement cache line" from a patch buffer into the lockable cache, and locking the "first replacement cache line" into the "lockable cache" as recited in Claims 1, 9, and 17. (*Office Action, Page 3, Third paragraph*). The Office Action then asserts

that *Brouwer* discloses these elements of Claims 1, 9, and 17 and that it would be obvious to modify *Leinfelder* with the recitations of *Brouwer*. (*Office Action, Page 3, Last paragraph – Page 4, Second paragraph*). The Office Action asserts that a person skilled in the art would modify *Leinfelder* with the recitations of *Brouwer* because a patch loaded into the cache “would have been prevented from being replaced and thus ensuring it to be available each time a patch is required.” (*Office Action, Page 4, Second paragraph*).

As described above, to make a rejection under 35 U.S.C. § 103, there must be some suggestion or motivation to “combine reference teachings,” and there must be a reasonable expectation of success. (*MPEP § 2142*). However, the teaching or suggestion to make the claimed combination and the reasonable expectation of success “must both be found in the prior art, not in applicant's disclosure.” (*MPEP § 2143*). The Applicants’ specification makes clear that “locked cache lines” are prevented “from being candidates for eviction,” thereby providing “predictable code fetch for performance sensitive (i.e., time sensitive) code sequences.” (*Application, Page 11, Lines 6-10*). The Office Action is relying on the Applicants’ disclosure for the motivation to modify *Leinfelder* with the recitations of *Brouwer*. Because the Applicants’ disclosure cannot be relied upon in this manner, the Office Action fails to establish a *prima facie* case of obviousness against Claims 1, 9, and 17.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 9, and 17 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-21.

III. CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

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